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Docket No. 10305US02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

YUNG YIP et al.

Serial No.: 10/822,884

Filed: April 13, 2004

For: STATIC DISSIPATIVE HOUSING FOR
DATA CARTRIDGE CARRYING
NON-TAPE STORAGE MEDIUM

Examiner: Thanh Q. Nguyen

Group Art Unit: 2182

CERTIFICATE OF TELEFACSIMILE TRANSMISSIONMail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450Examiner Thanh Q. Nguyen
Fax No.: (571) 273-8300


Dear Sir:

I certify that the following pages are being telefacsimile transmitted to the U.S. Patent and Trademark Office on the date shown below:

1. Reply Brief to Examiner's Answer with Certificate of Facsimile (4 pages)

Respectfully submitted,

Date

6/17/8
Eric D. Levinson
Reg. No. 35,814Imation Legal Affairs
P.O. Box 64898
St. Paul, Minnesota 55164-0898
Telephone: (651) 704-3604
Facsimile: (651) 704-5951**5 PAGES - INCLUDING COVER PAGE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Yung Yip et al.

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17 June 2008

By:

Name: Eric D. Levinson

REPLY BRIEF TO EXAMINER'S ANSWER**Mail Stop Appeal Brief – Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir/Madam:

This Reply Brief is presented in response to the Examiner's Answer mailed April 17, 2008, and in support of the Notice of Appeal filed October 3, 2007 and the Corrected Appeal Brief filed February 6, 2008, appealing the rejection of claims 1-8 and 16-20 of the above-identified application as set forth in the Final Office Action mailed July 3, 2007.

At any time during the pendency of this application, please charge any fees required or credit any overpayment due to Deposit Account No. 09-0069 pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees required to Deposit Account No. 09-0069 under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Appellant respectfully requests reconsideration and reversal of the Examiner's rejection of pending claims 1-8 and 16-20.

Reply Brief to Examiner's Answer

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ARGUMENT**Reply to Examiner's Response to Argument**

Regarding the rejection of claims 1-8 and 16-20 under 35 U.S.C. 103(a) as being unpatentable over Albrecht et al. US Publication No. 2002/0159182 in view of Waggoner et al. US Publication No. 2004/0113129 and "STAT: A guide to LNP's line of thermoplastic composites for electrostatic dissipation" (STAT), Appellant again notes that independent claim 1 includes, amongst other things, **"a housing having a surface resistivity in a range of approximately 10^6 ohms/square to approximately 10^{12} ohms/square, wherein the housing is adapted to dissipate a static charge of the data cartridge,"** and notes that independent claim 16 includes, amongst other things, **"a housing formed of a material including a static dissipative polymer and having a surface resistivity in a range of approximately 10^6 ohms/square to approximately 10^{12} ohms/square, wherein the housing is adapted to dissipate a static charge of the data cartridge."**

Regarding the Albrecht reference, Appellant again notes that the Albrecht reference discloses a data storage cartridge having a data storage device, such as an encased magnetic disk drive assembly, supported and mounted in a cartridge shell with the data storage cartridge having a backing plate 70 electrically coupled to the data storage device by means of land 85 of flex cable 65 such that backing plate 70 and land 85 of flex cable 65 form an electrostatic discharge path from the data storage device to the backing plate and through the electrically semiconductive material to the alignment pins of the transfer station which are electrically grounded (see para. [0066]; Fig. 18).

The electrostatic discharge path for the data storage cartridge of the Albrecht reference, therefore, is provided from the data storage device to the backing plate and through the electrically semiconductive material to the alignment pins of the transfer station. Forming the cartridge shell of the data storage cartridge of the Albrecht reference of a static dissipative material, as suggested by the Examiner, however, would change the path of electrostatic discharge and, therefore, would change the principle of operation of the data storage cartridge of the Albrecht reference. If the proposed modification or combination of the prior art would

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change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In addition, Appellant notes that backing plate 70 and land 85 of flex cable 65 of the Albrecht reference already solve the problem of electrostatic discharge for the data storage cartridge of the Albrecht reference. Having already solved the problem of electrostatic discharge for the data storage cartridge, Appellant submits that a person of ordinary skill in the art having common sense at the time of the invention would not have reasonably looked to the Waggoner and/or STAT references to solve a problem already solved by the Albrecht reference. Appellant, therefore, respectfully submits that the Examiner has impermissibly used the instant claims as a guide or roadmap in formulating the rejection.

Furthermore, regarding the Examiner's assertion at page 5 of the Examiner's Answer that the recitation "wherein the housing is adapted to dissipate a static charge of the data cartridge" is "no more than an indication of intended use rather than a further limitation [of] the claim," Appellant submits that there is nothing intrinsically wrong in defining something by what it does rather than by what it is. *In re Hallman*, 655 F.2d, 212, 210 USPQ 609 (CCPA 1981). See also *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). In addition, in evaluating a claim, Appellant submits that patentable weight must be given to all claim limitations including functional language. *In re Angstadt*, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976). Accordingly, Appellant submits that all claim limitations of independent claims 1 and 16, including "wherein the housing is adapted to dissipate a static charge of the data cartridge," must be given patentable weight.

Accordingly, for the reasons set forth above, as well as the reasons set forth in the Corrected Appeal Brief filed February 6, 2008, Appellant submits that the Examiner has not established a *prima facie* case of obviousness of independent claims 1 and 16, and submits that independent claims 1 and 16 are each patentably distinct from the Albrecht, Waggoner, and STAT references. Furthermore, as dependent claims 2-8 further define patentably distinct independent claim 1, and dependent claims 17-20 further define patentably distinct independent

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claim 16, Appellant submits that these dependent claims, in addition to the reasons set forth in the Corrected Appeal Brief filed February 6, 2008, are also patentably distinct from the Albrecht, Waggoner, and STAT references. Appellant, therefore, respectfully submits that the rejection of claims 1-8 and 16-20 under 35 U.S.C. §103(a) is not correct and should be withdrawn, and submits that claims 1-8 and 16-20 should be allowed.

CONCLUSION

For the above reasons, Appellant respectfully submits that the art of record neither anticipates nor renders obvious the claimed invention. Thus, the claimed invention does patentably distinguish over the art of record. Appellant, therefore, respectfully submits that the above rejections are not correct and should be withdrawn, and respectfully requests that the Examiner be reversed and that all pending claims be allowed.

Respectfully submitted,

Date: 6/17/8
Eric Levinson
Reg. No. 35,814

IMATION CORP.
P.O. Box 64898
St Paul, MN 55164-0898
Telephone: (651) 704-3604
Facsimile: (651) 704-5951